REMARKS

Claims 1 - 19 are pending; Claims 1 - 19 stand rejected. Reconsideration of the present Application is respectfully requested in light of the Amendments and Remarks made herein.

Claims 1-2, 4-8, and 10 stand rejected, pursuant to 35 U.S.C. 103, as being unpatentable over Goldberg et al (U.S. Patent No. 6,161,082) in view of Chin (U.S. Patent Application No. 20010029455).

Claims 7 and 8 stand rejected, pursuant to 35 U.S.C. 103, as being unpatentable over Goldberg et al (U.S. Patent No. 6,161,082) in view of Chin (U.S. Patent Application No. 20010029455) and King (U.S. Patent No. 6,532,446).

Claims 3, 12-16, 18 and 19 stand rejected, pursuant to 35 U.S.C. 103, as being unpatentable over Goldberg et al (U.S. Patent No. 6,161,082) in view of Chin (U.S. Patent Application No. 20010029455) and Sukeda (U.S. Patent No. 5,854,997).

Claim 9 stands rejected, pursuant to 35 U.S.C. 103, as being unpatentable over Goldberg et al (U.S. Patent No. 6,161,082) in view of Chin (U.S. Patent Application No. 20010029455), Sukeda (U.S. Patent No. 5,854,997), and King (U.S. Patent No. 6,532,446).

Claim 17 stands rejected, pursuant to 35 U.S.C. 103, as being unpatentable over Goldberg et al (U.S. Patent No. 6,161,082) in view of Chin (U.S. Patent Application No. 20010029455), Sukeda (U.S. Patent No. 5,854,997), and Emery (U.S. Patent No. 5,727,057).

Applicant traverses these rejections, and deems them overcome, at least in that the Official Action fails to make out a prima facia case of obviousness with respect to the amended Claims for the reasons set forth below.

35 USC §103(a) recites:

> [a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Accordingly, MPEP 706.02(j) states:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine

7

reference teachings. Second, there must be a reasonable expectation of success. ***Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

As stated in each of the independent claims of the instant application as amended, the method and system of the present invention includes the display, to the user of the mobile terminal when the user speaks into the mobile terminal, of only selected ones of that user's registered sentences from which a translation is to be selected. Applicant respectfully submits that Goldberg is a network-based translator, and, as such, does not teach displaying to the user, when the user speaks into the mobile terminal, of *only ones of the registered ones* from a plurality of available sentences for translation. Chin, Sukeda and King fail to overcome at least this deficiency of Goldberg.

Due to the display of only the registered sentences to the user of a mobile terminal, the user may readily realize, in real time upon speaking into the mobile terminal, whether the mobile terminal, and/or remote translator, has properly recognized what the use has said into the mobile terminal. Thereby, the present invention provides a higher recognition rate for translation than is available in the prior art, and thus the present invention additionally provides a high accuracy rate for translations not available in the prior art. *See Specification, Paragraph 0045, last 6 lines.* Goldberg, either alone or in combination with Chin, Sukeda and/or King fails to provide such improvements in recognition and accuracy rates for translation.

Applicant thus respectfully submits that independent claims 1, 12 and 18 are in condition for allowance. Further, Applicant respectfully submits that each of claims 2 – 11, 13 – 17 and 19 are allowable, at least by virtue of an ultimate dependence on allowable claims 1, 12 and 18, respectively.

CLAIM TO PRIORITY

Applicant notes that neither the current Office Action nor the previous Office Action acknowledged receipt of the claim to priority and the corresponding certified copy of the priority application. The Examiner is respectfully requested to indicate such acknowledgement in a subsequent communication.

CONCLUSION

In view of all the above, Applicants respectfully submit that certain clear and distinct differences as discussed exist between the present invention as now claimed and the prior art references upon which the rejections in the Office Action rely. These differences are more than sufficient that the present invention as now claimed would not have been anticipated nor rendered obvious given the prior art. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application as amended is respectfully solicited. A Notice of Allowance for Claims 1 - 19 is earnestly solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicant's undersigned representative at the address and phone number indicated below.

Respectfully submitted,

Stanley P. Fisher
Registration Number 24,344

Juan Carlos A. Marquez
Registration No. 34,072

Thomas J. McWilliams
Registration No. 44,930

REED SMITH LLP
3110 Fairview Park Drive
Suite 1400
Falls Church, Virginia 22042
(703) 641-4200
October 13, 2004